



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

EXAMINER

ART UNIT

PAPER NUMBER

15

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/158,982

Applicant(s)

Bullard et al.

Examiner

Ardin Marschel

Group Art Unit

1631



X Responsive to communication(s) filed on Jan 2, 2001

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133) Extensions of time may be obtained under the provisions of 37 CFR 1.136(a)

Disposition of Claim

X Claim(s) 1-3 and 5-24 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

X Claim(s) 8-10 and 13-21 is/are allowed

X Claim(s) 1, 2, 5, 7, 11, 22, and 24 is/are rejected.

X Claim(s) 3, 6, 12, and 23 is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d)

All ☐ Some* ☐ None ☐ of the CERTIFIED copies of the priority documents have been received

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received. _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e)

Attachment(s)

X Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

X Interview Summary, PTO-413 (2 sheets)

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Applicants' arguments, filed 1/2/01/00, have been fully considered and they are deemed to be persuasive to overcome previous rejections of record. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Upon reconsideration, however, the following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

Due to the setting forth of new grounds of rejection as summarized herein, the finality of the office action, mailed 8/30/00, is hereby withdrawn. Also, the amendment, filed 1/2/01, has been entered.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 101 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35

U.S.C. § 103(a).

Claims 1, 2, 5, 11, 22, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Farr et al. (P/N 5,811,231).

In the abstract of Farr et al. the measurement of transcription or translation levels from genes is disclosed as related to various stress promoters and/or the action of a compound at the subcellular level. Gene expression as set forth in the instant claims. Figures 1-11 of Farr et al. display said gene expression in a perspective 3-Dimensional manner with parameters for each expression level in the third dimension. One characteristic parameter is concentration of a compound which may alter gene expression and another is the stress promoter being evaluated regarding the gene expression. These stress promoters are discussed, for example, in column 7, line 46, through column 14, line 13. Examples 1-32 in columns 22-32 discuss some exemplary procedures by which to determine gene expression from the expression characterister for the gene being analyzed regarding promoter activity. The perspective 3-D graphs of the results are displayed as summarized in column 3 for the Figures 1-11. The difference between these studies and the instant claims is the usage of computer or automation practice by which to process the data. These automation practices only replace manual activities and are not a patentable distinction as evidenced by the legal decision of In re Venner (120 USPQ 192).

This legal decision at page 194, second column, item [6], states that it is well settled that providing a mechanical or automatic means to replace manual activity is not an invention. Thus, as explained further in said decision, there is no patentable distinction in replacing manual activity with an automatic means as instantly claimed.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice the instant invention because Farr et al. describes the data analysis and display of the instant invention which as noted above is obviously computerized as motivated for efficiency if desired.

Claims 3, 6, 12, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 8-10 and 13-21 are allowed.

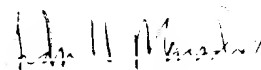
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1633 via the FTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 24 (December 23, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

February 23, 2001


ARDIN H. MARSCHEL
PRIMARY EXAMINER